

## Remarks

In the present response, claims 1 – 20 are presented for examination.

### Claim Rejections: 35 USC § 103(a)

Claims 1-2 and 4-20 are rejected under 35 USC § 103(a) as being unpatentable over US publication number 2004/0160430 (Tokunaga). These rejections are traversed.

Claims 1-2 and 4-20 recite one or more elements that are not taught or suggested in Tokunaga. These missing elements show that the differences between the combined teachings in the art and the recitations in the claims are great. As such, the pending claims are not obvious in view of the art to one of ordinary skill in the art. Some examples are provided below for the independent claims.

As one example, independent claim 1 recites creating a page division marker in pen-acquired data by making a gesture with the pen upon the first page of physical media indicative of termination of use of the first page of a document. The examiner argues that these recitations are shown layout A, B, or C boundaries indicated in Figures 9 and 12 and paragraphs [0042] and [0061] of Tokunaga. Applicants respectfully traverse.

Figure 9 in Tokunaga shows a relation between a layout and a dot pattern absolute coordinate space. Figure 12 shows a relation between digitized data entered in the paper and the dot pattern absolute space (see paragraphs [0025] and [0028]). Nowhere do these figures teach or even suggest creating a page division marker in pen-acquired data by making a gesture with the pen upon the first page of physical media indicative of termination of use of the first page of a document.

Paragraph [0042] in Tokunaga teaches that a paper with dot pattern A identifies an employee; paper with dot pattern B identifies an employee ID; and paper with dot pattern C identifies a date. Paragraph [0061] in Tokunaga teaches determining the dot pattern to which the coordinate string data corresponds. Nowhere do these paragraphs teach or even suggest creating a page division

marker in pen-acquired data by making a gesture with the pen upon the first page of physical media indicative of termination of use of the first page of a document.

As one example, independent claim 13 recites the pen has a processor having software adapted to associate time signals with the pen position data and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page having the same pattern, and to either: (i) create a page end marker in the pen-captured data; or (ii) store pen-acquired data from different physical pages, each having the same pattern, in different electronic files in the memory of the pen. **The examiner admits that “Tokunaga fails to teach or suggest” these recitations** (see OA mailed 05/11/2011 on pages 2-3). This admission shows that the examiner has failed to establish a *prima facie* case to reject claim 13 with Tokunaga.

The examiner cites various sections of Tokunaga, such as paragraphs [0043], [0056], [0060], and [0063]. These paragraphs fail to cure the admitted deficiencies in Tokunaga. Nowhere do these paragraphs teach or even suggest the pen has a processor having software adapted to associate time signals with the pen position data and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page having the same pattern, and to either: (i) create a page end marker in the pen-captured data; or (ii) store pen-acquired data from different physical pages, each having the same pattern, in different electronic files in the memory of the pen.

As one example, independent claim 19 recites create an end of electronic document division marker in pen-acquired data by making a gesture with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal. Tokunaga fails to teach or suggest these recitations.

The examiner cites box 320 of Figure 3 in Furukawa to reject recitations found in dependent claim 3. This box, however, is a confirmation box. Marking of this box does not create an end of electronic document division marker in pen-

acquired data by making a gesture with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal.

For at least these reasons, claims 1-2 and 4-20 are allowable over Tokunaga.

**Claim Rejections: 35 USC § 103(a)**

Claim 3 is rejected under 35 USC § 103(a) as being unpatentable over US publication number 2004/0160430 (Takonaga) in view of US publication number 2005/0093832 (Furukawa). This rejection is traversed.

As explained above, independent claim 1 recites elements not taught or even suggested in Tokunaga. Furukawa fails to cure these deficiencies. For at least these reasons, dependent claim 3 is allowable over Tokunaga in view of Furukawa.

### **CONCLUSION**

In view of the above, Applicants believe that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should be directed to the following address:

**Hewlett-Packard Company**  
Intellectual Property Administration  
3404 E. Harmony Road  
Mail Stop 35  
Fort Collins, CO 80528

Respectfully submitted,  
/Philip S. Lyren #40,709/

Philip S. Lyren  
Reg. No. 40,709  
Ph: 832-236-5529